



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FISH & RICHARDSON PC
PO BOX 1022
MINNEAPOLIS MN 55440-1022

COPY MAILED

JAN 22 2008

OFFICE OF PETITIONS

In re Application	: DECISION ON APPLICATION
Koster, et al.	: FOR PATENT TERM ADJUSTMENT
Application No. 09/067,337	: AND NOTICE OF
Filed: April 27, 1998	: INTENT TO ISSUE
Patent No. 7,094,943	: CERTIFICATE OF CORRECTION
Issued: August 22, 2006	:

This is a decision on the "PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(d)", filed October 20, 2006. Patentees request that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from six hundred forty-five (645) days to five hundred thirty (530) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **five hundred forty-three (543)** days.

As a Continued Prosecution Application (CPA) was filed in the instant application on March 12, 2001, the application is entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. §154(b) and 37 C.F.R. §§1.702 through 1.705. See MPEP 2730.¹

On February 8, 2006, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

¹ See MPEP 2730.

On May 8, 2006, Applicants timely² submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance was five hundred thirty-two (532) days. The application for patent term adjustment was granted in part in a decision mailed on June 23, 2006. The decision accorded a PTA of five hundred thirty (530) days.

On August 22, 2006, the application issued into Patent No. 7,094,943, with a PTA of six hundred forty-five (645) days. Applicants were accorded additional PTO delay of two hundred twenty-two (222) days for the Office's failure to issue the patent within three years. In addition, applicants were assessed one hundred seven (107) days of applicant delay for filing an IDS on May 5, 2006, after the mailing of the Notice of Allowance.

Under the circumstances of this case, it is concluded that the filing of applicant's IDS is not a failure to engage under 37 C.F.R. §1.704(c)(10). A review of the record reveals that applicant previously submitted the IDS on January 12, 2001. The IDS submission on May 5, 2006 also indicates that it was requested by the examiner. Accordingly, the assessment of one hundred seven (107) days of applicant delay with respect to this filing is not warranted.

Patentees point the Office's attention to the fact that they should not have been awarded additional PTO delay of two hundred twenty-two (222) days for the Office's failure to issue the patent within three years. Patentees are correct.

The instant patent issued 3 years and 634 days after the filing date of the CPA (not taking into effect the time between the filing of the RCE and the date the patent issued. See 37 C.F.R. § 1.703(b)). However, any days of delay for Office issuance of the patent more than 3 years after the filing date of the CPA, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent, will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

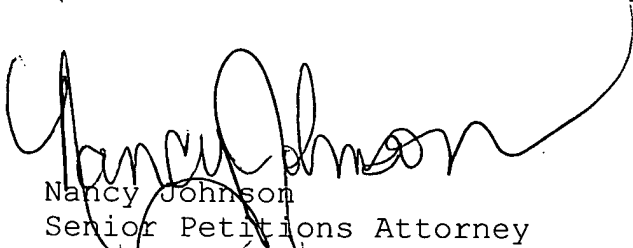
² Applicants filed the application for patent term adjustment together with the payment of the issue fee.

See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, the period of delay of 634 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 621 days pursuant to grounds specified in 1.702(a)(2) (for the episodes of delay of 39, 15, and 567 days). Thus, at issuance, only an additional period of 13 days should have been entered for a total of 543 days.

The Office thanks Patentees for their good faith and candor in bringing this matter to the Office's attention.

The matter is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 CFR 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **five hundred forty-three (543)** days subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,094,943 B2
DATED : August 22, 2006
INVENTOR(S) : Koster et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 645 days

Delete the phrase "by 645 days" and insert – by 543 days--